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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,020	02/09/2005	Hideyuki Agata	263483US6PCT	7564

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
JONES, HEATHER RAE	

ART UNIT	PAPER NUMBER
2621	

NOTIFICATION DATE	DELIVERY MODE
04/07/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/524,020	AGATA, HIDEYUKI	
	Examiner	Art Unit	
	HEATHER R. JONES	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 February 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/9/05,7/16/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6 and 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 6 and 7 defines a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed program can stored on anything ranged from paper on which the program is written, to a program simply contemplated and memorized by a person.

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Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Okose (JP 2000-059731).

Regarding claim **1**, Okose discloses an information processing apparatus comprising: connection means for connecting to a reproduction device for reproducing content data recorded in a first format (paragraph [0012] – IEEE 1394 interface); content data acquisition means for acquiring said content data reproduced by said reproduction device connected to said connection means (paragraphs [0014] and [0015] – edit control part (109)); conversion means for converting a format of said content data acquired by said content data acquisition means from said first format to a second format (paragraph [0016] - MPEG encoder (101)); recording control means for executing control such that said content data converted to said second format by said conversion means is recorded from said information processing apparatus to a predetermined removable recording medium (paragraphs [0004] and [0026]); detection means for detecting a signal supplied from said reproduction device indicative that said reproduction device is connected to said connection means and reproduction of said content data by said reproduction device is ready (paragraphs [0014] and [0015]); and processing control means for executing control such that, if said signal is detected by said detection means, processing by said content data acquisition means, processing by said conversion means, and processing by said recording control means

are continuously executed in this order (paragraphs [0003], [0004], and [0014]-[0016]).

Regarding claim **2**, Okose discloses all the limitations as previously discussed with respect to claim 1 including that the apparatus further comprises: reproduction control means for controlling the reproduction of said content data by said reproduction device connected to said connection means (paragraphs [0014] and [0015] – edit control part (109)); and information acquisition means for acquiring time information of said content data from said content data of which reproduction is controlled by said reproduction control means (paragraph [0014]); wherein said content data acquisition means acquires said control data of which reproduction is controlled by said reproduction control means (paragraph [0014]); said recording control means executes control so as to record said content data of said second format to said recording medium on the basis of said time information of said content data acquired by said information acquisition means (paragraphs [0003], [0004], and [0014]-[0016]); and said processing control means, if said signal is detected by said detection means, executes control so as to execute the processing of said information acquisition processing, as one of said sequence of processing operations, before the processing of said recording control means (paragraphs [0014]-[0016]).

Regarding claim **3**, Okose discloses all the limitations as previously discussed with respect to claims 1 and 2 including that wherein said

reproduction device is a digital video tape recorder; said first format is a format of said digital video tape recorder (paragraph [0012] - tape recorder (101)); said content data acquired by said content data acquisition means is recorded to a digital video tape loaded on said digital video tape recorder (paragraph [0012] – magnetic tape); and said reproduction control means controls processing of reproduction, fast forward feed, and rewind of said digital video tape loaded on said digital video tape recorder, and stop of said processing (paragraph [0017]).

Regarding claim **4**, Okose discloses all the limitations as previously discussed with respect to claims 1 and 2 including that the content data is data formed by a moving image and audio data corresponding thereto, said information processing apparatus further comprising: determination means for determining, on the basis of said time information of said content data acquired by said information acquisition means, a quality of said moving image, a size thereof, and a quality of said audio data of said content data when said content data is corded to said recording medium under the control of said recording control means (paragraph [0014]), wherein said recording control means executes control so as to record said content data to said recording medium with said quality of said moving image, said size, and said quality of said audio data determined by said determination means (paragraph [0038]); and said processing control means, if said signal is detected by said detection means, executes control so as to execute the processing of said determination means after

the processing of said information acquisition means and before the processing of said recording control means as one of said sequence of processing operations (paragraphs [0014]-[0017]).

Regarding claim **6**, Okose discloses a program for making a computer execute, as a sequence of processing operations, in an order given, with a predetermined condition used as a trigger, the steps of: acquiring content data having a first format reproduced by a predetermined reproduction device (paragraphs [0014] and [0015] – edit control part (109)); converting the format of said content data acquired by the content data acquisition step from said first format to a second format (paragraph [0016] - MPEG encoder (0016)); and controlling so as to record said content data converted to have said second format in the conversion step to a recording medium that is detachable from said computer (paragraphs [0003], [0004], and [0014]-[0016]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okose as applied to claims 1, 2, and 4 above, and further in view of Nakaya (U.S. Patent 7,130,532).

Regarding claim **5**, Okose discloses all the limitations as previously discussed with respect to claims 1, 2, and 4, but fails to disclose wherein said second format is a format specified by the DVD standard, said information processing apparatus further comprising: generation means for generating a DVD menu of said content data acquired by said content data acquisition means on the basis of said time information of said content data acquired by said information acquisition means, wherein said recording control means executes control so as to record said content data having said second format to said recording medium on the basis of said DVD menu generated by said generation means; and said processing control means, if said signal is detected by said detection means, executes control so as to execute the processing of said generation means after the processing of said information acquisition means and before the processing of said recording control means as one of said sequence of processing operations.

Referring to the Nakaya reference, Nakaya discloses an information processing apparatus that converts an analog signal into MPEG format, wherein said second format is a format specified by the DVD standard, said information processing apparatus further comprising: generation means for generating a DVD menu of said content data

acquired by said content data acquisition means on the basis of said time information of said content data acquired by said information acquisition means (Figs. 6A and 9A; col. 9, lines 3-15), wherein said recording control means executes control so as to record said content data having said second format to said recording medium on the basis of said DVD menu generated by said generation means (col. 5, lines 21-44); and said processing control means, if said signal is detected by said detection means, executes control so as to execute the processing of said generation means after the processing of said information acquisition means and before the processing of said recording control means as one of said sequence of processing operations (col. 5, lines 21-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a DVD menu in the second format as created by Nakaya in the format conversion disclosed by Okose in order to provide the user the ability to manipulate the starting point of the DVD they are viewing, thereby making the DVD user friendly.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okose as applied to claim 6 above.

Regarding claim **7**, Okose discloses all the limitations as previously discussed with respect to claims 1, 2, and 4, but fails to disclose that the program further making said computer execute the steps of: controlling to display a predetermined symbol when a signal indicative that said

reproduction device has been connected to said computer and said content data can be reproduced by said reproduction device is entered, said signal being supplied from said reproduction device; and detecting the selection of said symbol by a user, display of said symbol being controlled in the display control step, wherein, if the selection of said symbol by said user is detected in the detection step, said program makes said computer execute the content data acquisition step, the conversion step, and the recording control step as a sequence of processing operations in this order by use of said detection as a trigger. Official Notice is taken that it is well known when using a software program that once an element is available in the program an icon is displayed for the user to select to begin a process. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an icon for the user to click in order to trigger the program to start so that way the user knew when the data was available to convert.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEATHER R. JONES whose telephone number is (571)272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2623

Heather R Jones
Examiner
Art Unit 2621

HRJ
March 29, 2008